

b.) at least one skin layer of a plastic film having a thickness of 10 to 100 μm coated on said plastic layer, and

c.) a scratch-resistant layer having a thickness of 1 to 10 μm supported by said plastic film,

and made by one of two processes as recited; as well as to each of these processes.

The rejections as unpatentable under 35 U.S.C. §103(a) of Claims 40-45, 49, 52, and 62 over U.S. 4,112,171 (Motter et al) in view of U.S. 5,525,401 (Hirmer); of Claims 46 and 47 over Motter et al in view of Hirmer, and further in view of U.S. 5,849,414 (Bier et al); of Claims 48, 50 and 51 over Motter et al in view of Hirmer, and further in view of U.S. 4,634,637 (Oliver et al); and of Claims 53-61 as unpatentable over Motter et al in view of Hirmer, and further in view of U.S. 4,386,042 (Tatebayashi), are respectfully traversed.

Motter et al is concerned with problems arising from protecting a glass substrate for automotive glazing with a plastic cover or shield (column 1, line 43 through the end of column 2). Motter et al disclose that their invention makes it possible to provide automobile glazings have such a protective cover or shield over an inboard glass surface that, in addition to inhibiting lacerative injuries, will not be adversely affected by exposure to the atmosphere, is unaffected by extreme cold, is clearly transparent and practically color free, does not adversely affect the Severity Index of the complete structure, and is highly resistant to marking, scratching, marring and abrasion (column 3, lines 1-11). While almost the entire disclosure of Motter et al is with regard to a structure which uses a glass-containing substrate, Motter et al does disclose that the substrate may be an "all-plastic structure" (column 1, line 38). However, Motter et al contains no further disclosure regarding the all-plastic structure, such as number of layers, substrate thickness, materials, etc. Moreover, one skilled in the art

reading Motter et al would be without a clue as to problems associated with the use of an all-plastic structure. Hirmer is concerned with a vehicle window comprising a relatively thin sheet of clear plastic material having opposed surfaces, and electrically operable defrosting grid adhered to one surface of the relatively thin sheet, and a relatively thick substrate layer of clear plastic having opposed surfaces curved into a vehicle window configuration. The relatively thick substrate layer is adhered to the one surface of the relatively thin sheet and the electrically operable defrosting grid adhered thereto while in contact therewith in a molten state under heat and pressure within a cavity defined by two generally parallel curved dye surfaces of cooperating injection molding dyes so that upon solidification the surfaces of the relatively thin sheet are retained in a curved configuration in generally parallel coextensive relation to corresponding curved surfaces of the relatively thick substrate layer. The relatively thin sheet is disclosed to have a thickness of 5 to 40 mils (column 3, lines 10-12), which is the same as 127 μm -1,016 μm , and the relatively thick substrate layer is disclosed to have a thickness of 50 to 500 mils (column 3, lines 53-54), which is the same as 1.27 to 12.7 mm.

The Examiner asserts that it would have been obvious to use the plastic substrate of Hirmer with its disclosed thickness, in place of the glass substrate of Motter et al.

However, it is not clear why one skilled in the art would make this substitution without the present disclosure as a guide. Why, for example, would one skilled in the art not also incorporate the relatively thin sheet of Hirmer, which has a thickness, as discussed above, which is greater than both the presently-recited at least one skin layer and said scratch-resistant layer? It is clear that the Examiner has selected from Hirmer only that which supports the rejection, without considering the references as a whole.

Moreover, all of the present product claims are now product-by-process claims. Even if one skilled in the art would have combined Motter et al and Hirmer, as suggested by the Examiner, why would one skilled in the art have done so using the presently-recited process steps?

Bier et al disclose a coating for polycarbonate molded parts obtained by hydrolytic polycondensation of an aluminum compound of an organofunctional silane and oxide compound, inclusive of fluorinated silanes disclosed as imparting hydrophobic properties and particularly good resistance to condensed water. Without the present disclosure as a guide, it is not clear why one skilled in the art would have combined Motter et al and Hirmer with Bier et al. Nevertheless, Bier et al do not remedy the basic deficiencies in the combination of Motter et al and Hirmer, as discussed above.

Oliver et al disclose a solar control film having various layers. The Examiner relies on Oliver et al for its disclosure of optically selective metal layers separated by dielectric layers, as well as decorative layers. Again, it is not clear why one skilled in the art would combine Oliver et al with Motter et al and Hirmer in the absence of Applicants' disclosure. Nevertheless, Oliver et al do not remedy the basic deficiencies of Motter et al combined with Hirmer, as discussed above.

Tatebayashi discloses molding a synthetic resin article having a hard coating. As clear from the disclosure of applicable materials in Tatebayashi, such as transparent windows for meters or clocks, Tatebayashi is concerned with relatively small articles in comparison to motor vehicle windows. See, for example, Example 2, which involves coating a lens with a diameter of 50 mm. Why, without the present disclosure as a guide, would one skilled in the art use the process of Tatebayashi to make **any** motor vehicle window, let alone the

presently-claimed window? Nor does Tatebayashi disclose the particulars of the recited process steps.

In the Office Action, in response to the above argument that it is not clear why one skilled in the art would use the plastic substrate of Hirmer with its disclosed thickness in place of the glass substrate of Motter et al, without the present disclosure as a guide, the Examiner points to column 1, lines 22-25 of Hirmer, which discloses that it is well known that plastic materials, such as polycarbonates, if employed in lieu of glass, could reduce the weight of a glass rear window. However, Hirmer goes on to disclose, which the Examiner does not comment on, that nevertheless, glass continues to be used because it is apparent that in order for motor vehicle makers to shift from glass to plastics, the plastic window must be cost effective in other ways besides weight reduction (column 1, lines 25-28). Thus, the Examiner has extracted from Hirmer only that disclosure which supports his rejection, without considering the reference as a whole. This is improper. See In re Ehrreich, 200 USPQ 504 (CCPA 1979), which proscribes picking and choosing isolated teachings in the art and requires consideration of "the entirety of the disclosure made by the references" in any evaluation under 35 U.S.C. §103.

The Examiner dismisses the above arguments with regard to differences in thickness by citing In re Rose, 105 USPQ 237 (CCPA 1955) for the proposition that a change in size is generally recognized as being within the level of ordinary skill in the art. In the pre-1952 case of Rose, the CCPA found that a claim limitation requiring that bundle of lumber be of such size and weight requiring handling by a lift truck did not distinguish over prior art disclosing such a bundle that could be lifted by hand, stating that the size of an article "is not **ordinarily** a matter of invention" (emphasis added.) 105 USPQ at 240. Thus, even if Rose is

applicable precedent today, it is not an absolute rule. Moreover, were it clear that the prior art disclosed or suggested that a glass substrate could be substituted with a plastic substrate to obtain a functionally similar article without consideration of any factors except weight, then the Examiner might have a point as to the obviousness of making the substitution. However, there is no such disclosure or suggestion in the art, and it is clear from the above-discussed disclosure in Hirmer that simply replacing a glass substrate with a plastic substrate involves consideration of other factors.

In response to Applicants' argument that the present claims are product-by-process claims, the Examiner asserts that the product nevertheless appears to be the same as or obvious from a product of the prior art. However, Applicants disclose in the specification beginning at page 7, line 24 the advantages in the final product formed when made from either of the recited processes herein. These properties are necessarily inherent in the product. The Examiner has not established that a product based on the above-combination of prior art references would have these properties.

With regard to process Claims 53-61 and the disclosure in Tatebayashi, the Examiner again cites Rose, *supra*, for the proposition that a change in size is generally recognized as being within the level of ordinary skill in the art, and that one skilled in the art would have found it obvious to "scale up" the production process to make larger articles. In reply, the fact situation is quite different from that in Rose, as discussed above. In addition, the Examiner's conclusion is based on no fact-finding. Can the Examiner identify **any** process used for making windows on the order of 50 mm in diameter that has also been used to make windows of a size for making motor vehicle windows? The Examiner's rationale is nothing more than "obvious to try," without any reasonable predictability of success.

"Obvious to try" has long been held not to constitute obviousness. In re O'Farrell, 853 F.2d 894, 903, 7 USPQ2d 1673, 1680-81 (Fed. Cir. 1988). A general incentive does not make obvious a particular result, nor does the existence of techniques by which those efforts can be carried out. In re Deuel, 34 USPQ2d 1210, 1216 (Fed. Cir. 1995).

Claim 44 and new Claims 63-65 are separately patentable. The Examiner appears to rely on the disclosure of a cured organopolysiloxane compound in Motter et al at column 4, lines 30-34 to meet the terms of Claim 44. The subject matter of these claims is described in the specification at the paragraph bridging pages 4 and 5 and provides especially advantageous results. The subject matter of Claims 44, and 63-65 is not simply a cured organopolysiloxane compound. Neither Motter et al, alone or combined with the other applied prior art, disclose or suggest the subject matter of these claims.

For all of the above reasons, it is respectfully requested that the rejection over prior art be withdrawn.

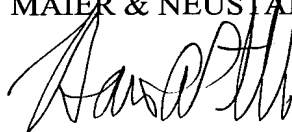
The rejection of Claims 40-62 under 35 U.S.C. §112, first paragraph, is respectfully traversed. **Submitted herewith** is a copy of the French standard R43. Thus, the rejection is now moot. Accordingly, it is respectfully requested that it be withdrawn.

All of the presently pending claims in this application are now believed to be in

immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to Issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Norman F. Oblon
Attorney of Record
Registration No. 24,618

Harris A. Pitlick
Registration No. 38,779



22850

(703) 413-3000
Fax #: (703) 413-2220
NFO:HAP:smi

I:\atty\HAP\12470796-am2.wpd

1247-0796-0V PCT



Marked-Up Copy	
S e r i a l	N o :
<u>09147,813</u>	
Amendment Filed on:	
<u>Oct 15, 2001</u>	

Claims 63-65 (New)

RECEIVED

OCT 19 2001

TC 1700